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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Rillie

Serial No.: 09/376,461

Filed: August 18, 1999

For: SKYLIGHT FLASHING

) Art Unit: 3634

) Examiner: Stodola

) 1128.006A

) February 14, 2004  
) 750 B STREET, Suite 3120  
) San Diego, CA 92101  
)

RENEWED PETITION UNDER 37 C.F.R. 1.181

Commissioner of Patents and Trademarks  
Washington, DC 20231

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Dear Sir:

GROUP 3600

This responds to the Decision dated February 10, 2004 dismissing the previous petition for failing to identify the relief sought.

This might be called a "petition *from* a suspension of the rules". Owing to the fact that the complained-of conduct evidently was vetted by the Group Director and who should thus properly recuse himself, it is respectfully suggested that this Petition be decided by the Assistant Commissioner's office.

The Commissioner is invited to consider whether prosecution can be properly reopened for a new search after a Board reversal of all previous rejections, when the Board did not indicate a remand for a new search in its prior decision. The examiner, who was not the examiner originally appealed, purports compliance with MPEP §1214.04. However, this section explicitly states that

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"The examiner should *never* regard such a [Board] reversal as a challenge to make a new search to uncover other and better references. *This is particularly so where the application has been transferred to an examiner other than the one who rejected the claims leading to appeal. The second examiner should give full faith and credit to the prior search*" (emphasis mine).

(see 37 C.F.R. § 1.118)

How conducting a new search in this instance comports with the above language is indeed mysterious.

The examiner next relies on MPEP §704.01, but has appeared to overlook the fact that Chapter 700 applies to general examination pre-appeal, and that it cannot take precedence over contrary guidance in Chapter 1200 that is specifically directed to post-appeal action. Moreover, the relied-upon section of Chapter 700 again repeats that full faith and credit are to be given to a prior examiner's search, unless there is clear error in the action taken or knowledge of the prior art. The examiner now evidently contends there was such clear error, but without elaborating on what it might have been. The "clear error" being complained of presumably is not of the action taken, because the "action taken" would refer to the reversal by the Board. And, no evidence has been presented as to why the examiner and the Board clearly erred in their knowledge of the prior art. Indeed, the Board's thorough opinion reversing the prior rejections evidences a keen understanding of the prior art. Reliance on this section of the MPEP for the examiner's behavior thus appears to be misplaced.

The examiner then attempts to make two lawyerly arguments about MPEP §1214.04 which, like many such arguments, are too clever by half. He first argues that the third paragraph "provides clear authority" to reopen prosecution. Indeed it does, but only under limited circumstances that the examiner fails to mention, namely, when the examiner has *specific* knowledge of references indicating unpatentability. Despite the examiner's representation to the contrary, this was plainly not the case here, since the new references

being applied against Claims 3 and 7 (Clarke et al. and Deutsch et al.) were all uncovered pursuant to a new search that yielded several other new references as well. If the examiner had "specific" knowledge of the three new references, why was a new search required to find them?

The "specific knowledge" proviso of the third paragraph does indeed make sense, however, when one reads it, in conjunction with the preceding prohibition against a new search, to permit the assertion of references that the examiner specifically knows of without having to dig them up from a search, e.g., patents currently before the examiner in another case. Otherwise, reading it as advocated by the examiner more or less has the effect of eliminating from the MPEP the above-quoted guidance against more searching post-decision absent a remand to do so.

The examiner then plays a little word game, noting that MPEP §1214.04 doesn't really prohibit a new search, it only prohibits an examiner from feeling "challenged" to perform one. This of course reduces the MPEP from an objective source of procedural authority to an advisory document the compliance with which depends on an examiner's subjective state of mind and discretionary proclivity to engage in semantics. The fact that this argument is being made at all demonstrates the bankruptcy of the examiner's purported support for authority to do what he did.

The examiner concludes his rationalizing with the observation that "in any event, if the claimed subject matter is unpatentable, applicant is not entitled to it under any circumstances." This bears more than a whiff of pleading that the end justifies the means, a particularly unfortunate attitude in a federal agency whose permissible conduct is supposed to be clearly authorized in writing, not merely hinted at or justified after the fact as a *fait accompli*. What Appellant is arguing here is not the substantive merits of the new art uncovered during the search, which are dealt with in the Supplemental Appeal Brief, but conduct by a Patent

Office employee that plainly finds no clear authorization in the Patent Office's own procedures and that, if anything, appears to be discouraged by the MPEP.

It may be that despite MPEP Chapter 1200, the Patent Office favors new searching after a Board reversal without remand for a search. It may also be that although Appellant believes the examiner's rationale is on shaky ground, the Commissioner may agree with it. If that is the case, it nonetheless should be indisputable that in light of the above-discussed sections of the MPEP, the MPEP is less than clear on this point. In that event, it is respectfully suggested that the MPEP be amended to clearly state that an examiner may conduct a new search after a Board reversal without remand to do so, so that the public has fair notice that such conduct might be expected.

#### **RELIEF SOUGHT**

Applicant requests one or more of the following actions. Because the search was illegitimate as being unauthorized by the MPEP under the facts set forth above, Applicant requests that the search results be declared to be without effect, and the application passed to issue. In the event that the Patent Office believes the search results to raise a substantial new question of patentability, the Patent Office is requested to abide by its own rules, and subsequent to allowing the application to issue, instigate a Reexamination proceeding if it so chooses as provided by the rules. That is the only legitimate avenue open to it, regardless of any convenience that might be afforded by skipping the rules and considering the search results now.

Absent taking the above action, Applicant requests the following. First, Applicant requests that the Group Director personally involve himself in any continuing prosecution of this application to ensure that the examiner does not continue to churn the case and turn out endless searches, including searches that are

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illegitimately performed after Board reversals. Second, Applicant requests that a full explanation be made of record as to how the Patent Office intends to rectify the complained-of behavior. If the Patent Office believes the Examiner has done nothing wrong, it should state its reasons for its beliefs, with citations to relevant supporting Rules. If it determines that the examiner was wrong but that the search results must still be considered, it should (1) state what, if any, corrective action will be taken to avoid violations of its rules and in particular violations by the examiner in the future; and (2) make of record its rationale for granting credence to search results that have been illegitimately obtained.

Respectfully submitted,



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